

### **Remarks**

Claims 12-20 are pending. Claim 12 is rejected under 35 U.S.C. § 102(b) as being anticipated by Sawa (5,228,190). Claims 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawa in view of Kurosawa et al. (4,748,837). Claims 16-20 are allowed. Applicants have amended claims 12 and 13.

The amendments to claims 12 and 13 are not intended to alter the scope of the claims, but merely to emphasize that, as used in the present application, “unitary” means “one-piece.” Antecedent support for the amendment to claim 12 is found in paragraph 0011 of the present application, which recites, *inter alia*, “a unitary, i.e., one-piece, panel 10. . . .” (emphasis added).

Amended claim 12 recites, *inter alia*, “providing a one-piece panel having a first portion formed as a[n] . . . outer panel and a second portion formed as a[n] . . . inner panel.” (emphasis added). Although other separate pieces, e.g., reinforcements, may be attached to the one-piece panel within the scope of the claimed invention, claim 12 recites providing a *one-piece panel* that includes both an inner panel portion and an outer panel portion.

For a rejection to be proper under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

The Examiner states that “Sawa discloses: . . . providing a unitary panel having a first portion formed as a[n] . . . outer panel (Wo) and a second portion formed as a[n] . . . inner panel (Wi) (col. 1, lines 7 and 8).” However, the text of Sawa cited by the Examiner in support of the rejection, i.e., column 1, lines 7 and 8, merely recites that the “present invention relates to a roller type hemming apparatus for hemming, for example, of a door panel for a vehicle,” and

does not teach that a one-piece panel has “a first portion formed as a[n] ... outer panel and a second portion formed as a[n] ... inner panel,” as recited by claim 12.

Sawa further states, at column 3, lines 36-37, that “[t]he workpiece W is, for example, a door panel composed of an outer panel Wo and an inner panel Wi.” Sawa does not *expressly* teach that the door panel W is a one-piece panel, and that the outer panel Wo is a “first portion” of the one-piece panel and the inner panel Wi is a “second portion” of the one-piece panel, as recited by claim 12. Sawa does not *inherently* teach that the door panel W is a one-piece panel, and that the outer panel Wo is a “first portion” of the one-piece panel and the inner panel Wi is a “second portion” of the one-piece panel, as recited by claim 12.

To rely on the inherency of a claimed element or feature in a prior art reference, the Examiner must provide extrinsic evidence that the claimed element or feature is necessarily present in the reference. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). See also MPEP § 2112.

The door panel W of Sawa is not *necessarily* a one-piece panel, with a first portion of the one-piece panel formed as an outer panel and the second portion formed as an inner panel, because the door panel W of Sawa may be composed of multiple pieces, i.e., separate inner and outer panels. Therefore, Sawa does not inherently teach the limitations of claim 12.

Indeed, as used by those skilled in the art, a “door panel” does not necessarily mean a one-piece panel, but rather refers to a multiple-piece panel having inner and outer panels formed from separate blanks. For example, Nakamori teaches, in U.S. Patent No. 5,787,646, that “[i]n general, a door panel for use in motor vehicles is constructed in such a manner that an inner panel, a hinge panel, and a belt-like reinforcement are joined together by means of a welding

process to produce an inner panel assembly which, in turn, is joined to an outer panel using a hemming process.” (column 1, lines 13-18) (emphasis added). Thus, a door panel is typically formed when an inner panel is joined to an outer panel; the inner panel and the outer panel of the door panel are separate pieces, and not portions of a one-piece panel, as recited by claim 12. See, e.g., Figure 1 of Nakamori.

Claim 12 also recites “subsequent to said providing a one-piece panel, bending the panel to form a crease between the first portion and the second portion.” (emphasis added). The Examiner states that Sawa discloses “subsequent to the providing a unitary panel, bending the panel lo [sic] form a crease between the first portion and the second portion (Fig. 1).”

However, as shown in Figure 1 of Sawa, Sawa does not teach bending “a one-piece panel having a first portion formed as a[n] ... outer panel and a second portion formed as a[n] ... inner panel,” as recited by claim 12, but instead teaches bending a panel forming only an outer panel. More specifically, as depicted in Figure 1 of Sawa, the hem roller 4 bends only the outer panel  $W_o$ , and does not bend a one-piece panel having a first portion formed as an outer panel and a second portion formed as an inner panel.

Accordingly, Sawa does not teach all of the elements and limitations of claim 12, and therefore the rejection of claim 12 under 35 U.S.C. § 102(b) is improper.

Moreover, claim 12 recites that the “first portion” of the one-piece panel is “formed as a vehicle body compartment lid outer panel” and that the “second portion” of the one-piece panel is “formed as a vehicle body compartment lid inner panel.” Sawa teaches a “door panel,” and not a vehicle body compartment lid, such as a hood or a decklid.

Claims 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawa in view of Kurosawa et al. Claims 13-15 ultimately depend from claim 12, and therefore include all of the elements and limitations of claim 12. Since the Examiner relies on Sawa for the elements and limitations of claim 12 in the rejections of claims 13-15, the rejection of claims 13-15 is improper for at least the same reasons set forth *infra* with respect to claim 12.

Applicants note with appreciation the allowance of claims 16-20.

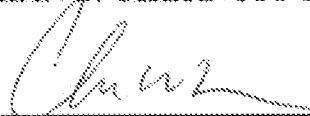
**CONCLUSION**

This Amendment is believed to be fully responsive to the Office Action mailed May 30, 2006. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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